

Applicant : William J. Beyda
Serial No. : 09/668,039
Filed : September 21, 2000

Attorney's Docket No.: 00P7906US
Reply to Office Action dated Sep. 14, 2004

Remarks

I. Status of claims

Claims 1-32 were pending.
Claims 6-13 and 19-28 have been withdrawn from consideration.
Claims 1, 14, and 29 are independent claims. Claims 2-5 and 30 depend from independent claim 1. Claims 15-18 and 31 depend from independent claim 14. Claim 32 depends from independent claim 29.

II. Objections to the drawings

The Examiner has objected to the drawings based on his assertion that the access restriction filter recited in the claims is not shown in the drawings. The claims have been amended to clarify that the access restriction filter is configured to interrogate an electronic message to detect a human-readable access restriction notice applicable to both electronic and non-electronic distribution of information contained in at least a portion of the electronic message.

FIG. 2 of the drawings clearly shows an access restriction filter 40 that includes a message interrogator 42 that is configured to interrogate an electronic message to detect a human-readable access restriction notice applicable to both electronic and non-electronic distribution of information contained in at least a portion of the electronic message. The specification explains that "access restriction filter 40 includes a message interrogator 42 that is configured to interrogate an electronic message for an access restriction notice" (page 4, lines 21-23). The specification also explains that:

the term "access restriction notice" is intended to refer to any notice restricting access to information associated with the notice. Exemplary access restriction notices include "Copyright," "Confidential," "Proprietary" and "Internal Use Only."

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When associated with information contained in an electronic message, each of the exemplary types of access restriction notices listed above (i.e., "Copyright," "Confidential," "Proprietary" and "Internal Use Only") inherently applies to both electronic and non-electronic distribution of that information. For example, when an e-mail message or a text document contains a copyright notice symbol (©), the copyright notice symbol gives the reader notice that copyright restrictions apply to both electronic and non-electronic distribution of the information contained in the message or document.

The specification additionally provides numerous examples of ways in which the access restriction filer 40 detects human-readable access restriction notices (page 5, lines 11-30):

... the way in which access restriction filter 40 interrogates an electronic message depends on the type of content contained in the message. If the electronic message contains computer-readable characters (e.g., text represented by ASCII codes) (step 60), characters in the message are compared to one or more stored access restriction notices (step 62). For example, if the electronic message contains an e-mail message or a text document, access restriction filter 40 may search the entire e-mail message or text document for a copyright notice symbol (©). Alternatively, access restriction filter 40 may search the entire e-mail message or text document for certain kinds of access restriction notices (e.g., "Confidential," "Proprietary" and "Internal Use Only"). ... If the electronic message contains a still image (e.g., a TIF, XIF, BMP, JPEG, GIF or PDF image) (step 68), access restriction filter 40 translates characters in the image into a computer-readable format (e.g., ASCII codes) (step 70). Conventional character recognition technology may be used to translate the image data into computer-readable form. The translated characters are compared to one or more stored access restriction notices (step 72). ...

Thus, the drawings clearly show the claimed feature of an access restriction filter that is configured to interrogate an electronic message to detect a human-readable access restriction notice applicable to both electronic and non-electronic distribution of information contained in at least a portion of the electronic message. For this reason, the Examiner's objection to the drawings now should be withdrawn.

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III. Objections to the specification

The Examiner has objected to the specification under 35 U.S.C. § 112, first paragraph, for "failing to disclose how to interrogate access code (*sic*) from non-electronic distribution of electronic message."

As explained above, the drawings and the specification clearly describe the claimed access restriction filter, which is configured to interrogate an electronic message to detect a human-readable access restriction notice applicable to both electronic and non-electronic distribution of information contained in at least a portion of the electronic message.

Based on the Examiner's objection, it appears that the Examiner has assumed that the claimed access restriction filter is configured to interrogate a non-electronic message. To the contrary, however, the claims clearly recite that the access restriction filter is configured to interrogate an electronic message to detect a human-readable access restriction notice. It is the access restriction notice that is applicable to both electronic and non-electronic distribution of information contained in at least a portion of the electronic message.

For the reasons explained above, the Examiner's objection to the specification under 35 U.S.C. § 112, first paragraph, now should be withdrawn.

IV. Claim rejections under 35 U.S.C. § 112

The Examiner has rejected claims 1-5, 14-18, and 29-32 under 35 U.S.C. § 112, first paragraph, "for the reason set forth in the objection to the specification."

As explained above, the drawings and the specification clearly describe the claimed access restriction filter, which is configured to interrogate an electronic message to detect a human-readable access restriction notice applicable to both electronic and non-electronic distribution of information contained in at least a portion of the electronic message. Thus, for the reasons explained above, the Examiner's rejected of claims 1-5, 14-18, and 29-32 under 35 U.S.C. § 112, first paragraph, now should be withdrawn.

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V. Claim rejections under 35 U.S.C. § 103

The Examiner has rejected claims 1-3, 5, 14-16, 18, and 29 under 35 U.S.C. § 103(a) over Tsumura (U.S. 5,842,023).

The Examiner has rejected claims 4 and 17 under 35 U.S.C. § 103(a) over Tsumura in view of Nakagawa (2003/0159065).

A. Independent claims 1, 14, and 29

Independent claims 1, 14, and 29 have been amended and now substantially recite that (1) an electronic message is interrogated to detect a human-readable access restriction notice applicable to both electronic and non-electronic distribution of information contained in at least a portion of the electronic message, and (2) the detection of the access restriction notice is responded to in accordance with a prescribed transmission policy for handling electronic messages containing the detected human-readable access restriction notice. "Exemplary access restriction notices include "Copyright", "Confidential", "attorney-Client Privileged" or "Attorney Work Product", "Proprietary", and "Internal Use Only" (see, e.g., page 4, lines 8-10, of the application). When associated with information contained in an electronic message, each of these exemplary types of human-readable access restriction notices applies to both electronic and non-electronic distribution of that information. For example, when an e-mail message or a text document contains a copyright notice symbol (©), the copyright notice symbol gives the reader notice that copyright restrictions apply to both electronic and non-electronic distribution of the information contained in the message or document.

As explained in detail below, Tsumura's information service processor is not configured to interrogate an electronic message to detect a human-readable access restriction notice of the type that is applicable to both electronic and non-electronic distribution of information contained in at least a portion of the electronic message and to respond the detection of the access restriction notice in accordance with a prescribed transmission policy for handling electronic messages containing the detected access restriction notice. In addition, Tsumura does not teach or suggest anything about filtering electronic messages.

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1. Tsumura Fails To Teach Or Suggest Interrogating An Electronic Message To Detect A human-readable access restriction notice Applicable To Both Electronic And Non-Electronic Distribution Of Information Contained In At Least A Portion Of The Electronic Message And Responding To The Detection Of The Access Restriction Notice In Accordance With A Prescribed Transmission Policy For Handling Electronic Messages Containing The Detected Access Restriction Notice

Tsumura does not teach or suggest that his information service processor is configured to (1) interrogate an electronic message to detect a human-readable access restriction notice applicable to both electronic and non-electronic distribution of information contained in at least a portion of the electronic message, and (2) respond to the detection of the human-readable access restriction notice in accordance with a prescribed transmission policy for handling electronic messages containing the detected access restriction notice. Tsumura's approach restricts transmission of protected information based on electronic control information that is specified by the transmitter of the protected information. The control information, however, is not human-readable and applies only to electronic distribution of protected information by a suitably configured information service processor; the control information is not applicable to non-electronic distribution of protected information. In particular, with regard to transmission of information from the information service processor, Tsumura explains that (col. 18, lines 14-19):

Network retransfer enable/disable information 63 is used to determine whether or not a user can retransfer provided information to a network. When it is determined that the retransfer is enabled, a user may retransfer the main body of information to the network. When the retransfer is disabled, a user can not transfer information to the network.

Thus, in Tsumura's approach, the communication connector 2 implements the transmission policy of the information service processor based on the retransfer enable/disable information 63 that is associated with the protected information to be transmitted. The retransfer enable/disable information 63, however, is an attribute flag that is not human-readable and applies only to electronic distribution of the protected information. The retransfer enable/disable information 63

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does not apply to non-electronic distribution of the protected information. Indeed, the retransfer enable/disable information 63 has no meaning outside of Tsumura's electronic broadcast system.

It is noted that although Tsumura's information service processor refers to copyright information 44 that is associated with the protected information, the copyright information 44 does not constitute a copyright notice that is applicable to both electronic and non-electronic distribution of the protected information. Rather, the copyright information 44 merely lists "all the copyrights and the copyright holders that are related to the pertinent region" (col. 13, lines 54-56). In addition, the information service processor does not respond to the copyright information 44 in accordance with a prescribed transmission policy for handling electronic messages containing the copyright information 44. Instead, as explained above, the communication connector 2 implements the transmission policy of the information service processor based on the retransfer enable/disable information 63, not the copyright information 44.

Tsumura also does not teach or suggest anything that would have led one of ordinary skill in the art at the time of the invention to modify Tsumura's information service processor to interrogate an electronic message to detect a human-readable access restriction notice that is applicable to both electronic and non-electronic distribution of information contained in at least a portion of the electronic message. Tsumura's invention is directed to the electronic distribution of "copyrighted multimedia digital information to a user via a broadcast communication network" (col. 1, lines 6-7). Tsumura does not describe anything relating to a human-readable access restriction notice that is applicable to the non-electronic distribution of protected information. Therefore, one of ordinary skill in the art at the time the invention was made would not have been spurred by Tsumura's disclosure to modify the information service processor to interrogate an electronic message to detect a human-readable access restriction notice that is applicable to both electronic and non-electronic distribution of information contained in at least a portion of the electronic message.

The Examiner has acknowledged that "Tsumura does [not] explicitly disclose the restriction notice is applicable for non-electronic distribution of electronic message." Nevertheless, the Examiner has asserted that:

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In bona fide attempt examination, the reasonable interpretation of the claims as written is that the electronic message is converted to paper, i.e., internal office memo, with a stamp such as confidential, restriction, copyright notice or etc, and distribute by messenger as routinely conducted within most of the corporation. It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement a well-known and common message distribution as routinely practiced for distributing non-electronic form, e.g., manual distribution of electronic message as claimed, with the motivation of ensuring reliability of messaging or as a back up messaging service.

The Examiner, however, has misconstrued the claim language as requiring that the claimed access restriction filter is configured to interrogate a non-electronic message. To the contrary, however, the claims clearly recite that the access restriction filter is configured to interrogate an electronic message to detect a human-readable access restriction notice of a type that is applicable to both electronic and non-electronic distribution of information contained in at least a portion of the electronic message.

The Examiner's rejection, therefore, fails to explain what would have motivated one of ordinary skill in the art at the time the invention was made to modify Tsumura's electronic broadcast system to interrogate an electronic message to detect a human-readable access restriction notice that is applicable to both electronic and non-electronic distribution of information contained in at least a portion of the electronic message.

For at least this reason, the Examiner's rejection of claims 1-3, 5, 14-16, 18, and 29 under 35 U.S.C. § 103(a) over Tsumura now should be withdrawn.

2. Tsumura Fails To Suggest Anything About Filtering Electronic Messages

Tsumura's disclosure does not teach or suggest anything about filtering electronic messages, as recited in each of independent claims 1, 14, and 29. Instead, Tsumura's disclosure describes "an information service processor that supplies copyrighted multimedia digital information to a user via a broadcast communication network, and provides protection for such copyrighted information that is supplied" (col. 1, lines 5-8). One of ordinary skill in the art at the time of the invention reasonably would have considered Tsumura's disclosed system to be a

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digital content distribution and rendering system, not an electronic messaging system. Indeed, it would have been unreasonable for such a person to have considered the copyrighted multimedia digital information distributed by Tsumura's system to be an electronic message. For example, as a copyrighted work, such multimedia digital information is required to be a tangible original expression of an idea rather than a vehicle for exchanging the kinds of un-copyrightable commonplace ideas and expressions that are typically contained in electronic messages.

For at least this additional reason, the Examiner's rejection of claims 1-3, 5, 14-16, 18, and 29 under 35 U.S.C. § 103(a) over Tsumura should be withdrawn.

3. Conclusion

For the reasons explained above, the Examiner's rejection of claims 1-3, 5, 14-16, 18, and 29 under 35 U.S.C. § 103(a) over Tsumura now should be withdrawn.

B. Dependent claims 4 and 17

Dependent claim 4 incorporates the features of independent claim 1 and dependent claim 17 incorporates the features of independent claim 14.

Nakagawa fails to teach or suggest an electronic messaging approach in which an electronic message is interrogated to detect a human-readable access restriction notice that is applicable to both electronic and non-electronic distribution of information contained in at least a portion of the electronic message. Indeed, the digital works inspected by Nakagawa's copyright inspection apparatus are not electronic messages. In addition, the types of electronic watermarks that are inspected by Nakagawa's copyright inspection apparatus are only applicable to electronic distribution of the associated digital content.

In addition, Nakagawa does not make-up for Tsumura's failure to teach or suggest anything about filtering electronic messages. Indeed, Nakagawa does not teach or suggest anything about electronic messages. Nakagawa merely discloses a method of determining whether information that is extracted from digital content presented on web pages corresponds to

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copyright information that was embedded in a particular digital content in order to determine if the presented digital content "is one for which one holds the copyright" (¶ [0048]).

Thus, Nakagawa's disclosure would not have led one of ordinary skill in the art at the time of the invention to modify Tsumura's information service processor into an electronic messaging system for filtering electronic messages. Nor would Nakagawa's disclosure have led such a person to modify Tsumura's system to (1) interrogate an electronic message to detect a human-readable access restriction notice applicable to both electronic and non-electronic distribution of information contained in at least a portion of the electronic message, and (2) respond to the detection of the access restriction notice in accordance with a prescribed transmission policy for handling electronic messages containing the detected access restriction notice, as recited in claims 1 and 14.

For the reasons explained above, claims 4 and 17 are patentable over Tsumura and Nakagawa for at least the same reasons explained above in connection with independent claims 1 and 14.

VI. Conclusion

For the reasons explained above, all of the pending claims are now in condition for allowance and should be allowed.

Charge any excess fees or apply any credits to Deposit Account No. 19-2179.

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Respectfully requested,

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